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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,876	06/01/2001	Jean-Rene Authelin	F15028-US-CNT	2065
7590 12/02/2004			EXAMINER	
Ross J Oehler, Esq. Aventis Pharmaceuticals Inc. Patent Department Route 202/206 P.O. BOX 6800 BRIDGEWATER, NJ 08807-0800			OH, SIMON J	
			ART UNIT	PAPER NUMBER
			1615	
DATE MAILED: 12/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/871,876

**Applicant(s)**

AUTHELIN ET AL.

**Examiner**

Simon J. Oh

**Art Unit**

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Papers Received***

Receipt is acknowledged of the applicant's response and petition for extension of time, both received on 27 July 2004.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 12 and 13 under 35 U.S.C. 102(b) as being anticipated by Jinks is hereby withdrawn.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Jinks is hereby withdrawn.

The rejection of Claims 1-22 under 35 U.S.C. 103(a) as being unpatentable over Weishaupt *et al.* in view of Hagen *et al.* alone, or further in view of Capelle, Jr. *et al.* is maintained.

***Response to Arguments***

Applicant's arguments filed 27 July 2004 have been fully considered but they are not persuasive.

The examiner does not agree with the applicant's analysis of the prior art. Beginning with the applicant's characterization of prior art processes, in the passage cited by the applicant in the Weishaupt *et al.* patent at Column 4, Lines 19-30, the applicant has conveniently omitted that such cryogenic temperature ranges lie below  $-100^{\circ}\text{C}$ , as disclosed in Lines 30-34. Although the applicant has pointed out that the boiling point of helium is  $-268.6^{\circ}\text{C}$ , the examiner would like to note that the standard boiling points of argon, nitrogen and oxygen, all mentioned in the cited passage, range from  $-220^{\circ}\text{C}$  to  $-180^{\circ}\text{C}$ , which are well below the stated temperature of  $-100^{\circ}\text{C}$ . One of ordinary skill in the art, who would be familiar with the principles of thermodynamics, would be mindful that it is indeed possible for helium or any other gas to be in a liquid state at such a temperature, given sufficient pressure, a process parameter that is not recited within the instant claims.

In the process disclosed by Weishaupt *et al.*, the carrier gas is compressed prior to introduction in the milling chamber, as stated in the Abstract. This is a moot point, however, as the reference does not explicitly require a liquefied carrier fluid. Even in a compressed state, the carrier gas may not necessarily be in liquid form. In Column 7, Lines 8-10, pressures up to 8 atm are possible in the disclosed process, and even at such pressure, the carrier is described as a compressed gas, rather than as a liquid. This compressed carrier gas stream, cooled to a cryogenic temperature, is expanded through a nozzle as it enters the milling chamber. In such a process step, the carrier gas expands while decreasing in pressure and increasing in velocity, as

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stated in Column 1, Lines 52-67. Abiding by the principles of thermodynamics, in such an expanded form, it would be exceptionally unlikely that the carrier gas would be in any sort of liquid form, as such a rapid depressurization creates a powerful vaporization effect, assuming of course for the sake of argument that there was any liquid in the carrier to begin with.

It is clear then that the prior art use of the term "cryogenic" refers to a temperature range, rather than a characterization of the carrier's state of matter. The examiner cannot take such a narrow interpretation of the prior art. It is the position of the examiner that one of ordinary skill in the art, giving both the prior art and the claims in their present form their broadest reasonable interpretation, would find the claimed invention obvious in view of the prior art. See MPEP § 2111 and 2123.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (571) 272-0599. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Simon J. Oh  
Examiner  
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